

Remarks / Arguments

In response to the Office Action mailed April 10, 2003, Applicant submits this Amendment concurrently with a Petition for a Three-Month Extension of Time.

Claims 1-2, 4, and 6-20 were pending in this application. In the Office Action, the Examiner rejected Claims 1-2, 4, and 6-20. By this Amendment, Claim 1 has been amended to include the features of Claim 19, and claim 4 has been amended to include the features of Claim 20. Claims 19-20 have been canceled. The foregoing amendments and the following remarks are believed to be fully responsive to the Office Action and are believed to place the above-identified application in condition for formal allowance.

Further examination and reconsideration of the rejection are hereby requested.

The rejection under 35 USC §103

The Examiner has rejected claims 1 - 4 and 6 - 20 under 35 USC §103(a) as being unpatentable over Canadian Patent Application 2,172,237 (the "Canadian Patent Application"). This rejection is respectfully traversed.

Amended claim 1 recites a composite label including a first layer of printed polyester for displaying information at a first major surface of the label and a second layer for presenting information at a second major surface of the label, the second layer including a removable portion arranged to be separated from the label and secured to another object, and wherein the second layer is formed of a material having a density and softness less than the polyester, to allow the second layer to be cut or scored so as to define the removable portion, without compromising the integrity of the first layer. Accordingly, the composite label of this claim is defined as including a first and second layer having a particular configuration. In particular, the relative material properties of

the first and second layers have been defined insofar as the first layer is polyester and the second layer is formed of a material having a density and softness less than the polyester.

The Examiner has cited the following references or statements to argue that Claim 1 is obvious: (1) the Canadian Patent Application, (2) Applicant's statement of page 1, lines 10-17 of the specification, and (3) the Examiner's statement about the level of skill in the art.

First, the Canadian Patent Application discloses an assembly which comprises a carrier web (11) upon which is mounted a polyester label (20). An adhesive coating (21) is provided on an underside of the label and that is, in turn, removably attached to a varnish coating (18) of the web. The web is not a component of the label, and essentially acts as a carrier for the label. The label and adhesive layer is in fact referred to as a sub-assembly "S" that is individually applied to the web.

Second, the statement of page 1, lines 10-17 of the specification states, in part, that "[t]he broad concept of providing labels with removable stickers is well known Such a label is, however, known to be formed of a simple double layer construction of conventional laminated paper or polypropylene material," i.e., two layers of the same type of material, e.g., polypropylene. The Examiner states that "with respect to newly presented claims 19 and 20, applicants appear to admit that polypropylene would read on this particular newly claimed property" (paragraph 8, page 3 of the April 10 Office Action). Applicant has made no such admission. Whereas Applicant states in the specification that "polypropylene material" may be used in a label, applicant does not admit that the prior art of record discloses or suggests the *juxtaposition* of a polyester layer and a layer having a density and softness less than polyester.

Third, the Examiner's statement about the level of skill in the art is that "to select a material having a density less than polyester such as polypropylene and related films is not hindsight but well within the ordinary skill of the art."

It is respectfully submitted that Claim 1 is not rendered obvious by the proposed combination of the Canadian Patent Application in view of the applicant's statements and the examiner's observation. In order to establish a case of prima facie obviousness, the prior art reference must teach or suggest all of the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, *not applicant's disclosure*. (Emphasis added.)¹ In this case, the proposed combination does not teach or suggest all of the claimed features.

A feature of Applicant's invention as claimed in Claim 1 is the arrangement of a label having two layers, i.e., a layer of polyester positioned adjacent a layer having a density or softness less than the polyester. The juxtaposition of these two layers allows the second, softer layer to be cut or scored, while leaving the first, polyester layer intact. This feature is neither disclosed nor suggested by the Examiner's proposed combination. The Examiner has not cited any teaching or suggestion that the relative positioning of two layers in a composite label which allow one to be cut without compromising the integrity of the other is a desirable property in the manufacture of labels, *without relying on Applicant's disclosure*.

The proposed combination of references provides no such teaching. The Canadian Patent Application discusses the possible use of different materials and in fact describes an arrangement with a polyester web. The applicant's statement in the specification refers to a double layer of polypropylene labels. However, there is no suggestion whatsoever of combining two layers in the manner defined, in order to produce the *composite label* of this invention, and to realize the substantial benefit of being able to cut one layer while leaving the other layer intact. The defined construction of Claim 1 allows for the production of a dual purpose label, which is suitable as both a conventional label and a promotional and marketing tool by having a removable portion on a reverse side of the label. It is submitted the concept itself of applying such a label to

¹ *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991).

a bottle is unique and that the concept and label construction are intrinsically related in this instance.

Moreover, the suggestion that the invention of claim 1 would be obvious in light of the combination including the Canadian Patent Application, which merely discloses adhesive labels attached to an underlying web, is not supported by a proper rationale. The Canadian Patent Application is directed to a *single layer label* and a polyester *webbing*, and not to a double layer label. The Examiner has provided no suggestion or rationale that the polyester webbing can serve as a layer of the label. Accordingly, Claim 1, and claim 2 which depends from claim 1, are believed nonobvious and allowable over the proposed combination of references.

Claim 4 is believed allowable at least for the reasons discussed hereinabove. Claim 4 also recites a release strength factor of between 17 grams force / 50 mm and 30 grams force / 50 mm. The physical properties which allows the label to be used in conventional bottling equipment have been arrived at as a result of a substantial amount of research, and does not constitute an "obvious optimization.". For example, considerable efforts have been expended to achieve a label with appropriate layer thicknesses, in the order of 10's of microns and to achieve appropriate strengths with material of that thickness represents a significant advance in its own right. The Canadian Patent Application, however, simply describes an adhesive label mounted on a web, where the thickness of the label itself is described as being in the order of about 0.5 to about 4.0 mils. That clearly indicates the label would not be suitable for the same application as the present label. Accordingly, it is submitted the label construction of the invention, particularly with the material properties such as the defined thickness, represents a nonobvious improvement over the cited prior art. Claim 4, and claims 6-18, which depend from claim 4, are believed nonobvious over the proposed combination of references, and thus allowable.

Claim 18 is believed allowable, at least for all the reasons discussed above regarding Claims 1 and 4. In addition, claim 18 recites that the composite label is for use

with a bottle, with the label includes an aggressive adhesive applied to the second major surface in a region adjacent the removable portion, to facilitate secure attachment of the label to the bottle. The Canadian Patent Application, in combination with the additional references, neither discloses nor suggests such use of an aggressive adhesive. In fact, as discussed above, the Canadian Patent Application specifically describes that the webbing is stacked or rolled for shipping (page 3, lines 19-23). The use of an adhesive on the webbing would allow the webbing to stick together, thereby preventing the webbing from being useable after stacking or rolling. Such proposed modification of the reference would render the reference inoperable for its intended purpose. Accordingly, claim 18 is believed nonobvious and allowable over the cited combination of references.

Claims 19-20 have been canceled without prejudice, thereby obviating the rejection with respect thereto. As stated above, the features recited in canceled claims 19-20 have been incorporated into claims 1 and 4.

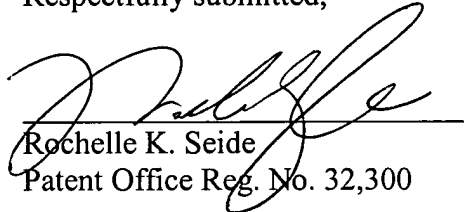
It is requested that the rejection of claims 1 - 4 and 6 - 20 under 35 USC §103(a) be withdrawn.

Conclusion

In view of the foregoing, Claims 1-2, 4 and 6-18 are believed allowable, and this application is believed to be in condition for formal allowance. Prompt and favorable allowance is requested.

Respectfully submitted,

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